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PATENT

Docket No. 05634/008

RECEIVED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

95 MAY 24 11:11-93

Inventor(s): John C. Harvey, James W. Cuddihy

GROUP 260

Serial No.: 08/113,329

Group Art Unit: 2602

Filing Date: 30 Aug 93

Examiner: D. Harvey

For: Signal Processing Apparatus and Methods

Commissioner of Patents and Trademarks
Washington D.C. 20231



INFORMATION DISCLOSURE STATEMENT

S I R:

In accordance with the duty of disclosure under 37 C.F.R. § 1.56(a) and in conformance with the procedures of 37 C.F.R. §§ 1.97-98 and M.P.E.P. § 609, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached Form PTO-1449. Copies of the listed references are provided herewith.

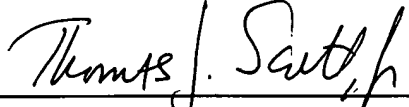
It is respectfully requested that the information above be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

CERTIFICATION AND/OR FEE

This IDS is being filed before the earlier of the mailing date of a final action or a notice of allowance. A check in the amount of \$210 is enclosed to cover the fee for the IDS submission under 37 C.F.R. § 1.97(c).

The Commissioner is hereby authorized to charge any additional fees required in connection with this communication to the deposit account of **Howrey & Simon**, deposit account number **08-3038**. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



Thomas J. Scott, Jr. (Reg. No. 27,836)

Dated: May 11, 1995

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REFERENCE CATEGORIES

U.S. Patent Application Ser. No. 08/113,329

GROUP A

2,573,349, 2,788,387, 2,864,885, 3,071,642, 3,238,297, 3,531,586, 3,536,833,
3,657,699, 3,684,823, 3,733,430, 3,736,369, 3,824,332, 3,885,089, 3,899,633,
3,914,534, 3,919,462, 3,934,079, 3,936,593, 3,936,594, 3,987,398, 4,025,947,
4,025,948, 4,058,830, 4,081,831, 4,130,833, 4,161,751, 4,253,114, 4,266,243,
4,304,990, 4,305,101, 4,313,132, 4,318,125, 4,322,745, 4,323,921, 4,323,922,
4,325,078, 4,336,553, 4,338,628, 4,353,088, 4,354,201, 4,364,081, 4,365,110,
4,379,205, 4,388,643, 4,389,671, 4,390,898, 4,398,216, 4,405,942, 4,424,532,
4,434,436, 4,467,139, 4,475,123, 4,536,791

GROUP B

2,573,349, 2,788,387, 2,864,885, 3,071,642, 3,531,586, 3,833,757, 3,934,079,
4,024,574, 4,058,830, 4,091,417, 4,104,486, 4,115,807, 4,225,884, 4,388,643,
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GROUP C

2,769,023, 2,866,962, 3,071,642, 3,238,297, 3,777,053, 3,882,392, 3,886,302,
3,890,461, 3,894,176, 3,899,633, 3,919,462, 3,934,079, 3,997,718, 4,058,830,
4,068,264, 4,081,831, 4,112,464, 4,115,662, 4,161,751, 4,163,255, 4,215,366,
4,253,114, 4,292,650, 4,322,745, 4,323,921, 4,323,922, 4,325,078, 4,338,628,
4,354,201, 4,388,643, 4,389,671, 4,390,898, 4,434,436, 4,467,139, 4,475,123,
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GROUP D

3,213,201, 3,693,090, 3,789,137, 3,819,852, 4,025,947, 4,215,370, 4,364,081,
4,365,110, 4,394,762, 4,398,216, 4,410,917, 4,424,532, 4,467,356

GROUP E

3,573,747, 3,798,610, 4,253,157, 4,339,798, 4,593,353

GROUP F

3,609,697, 3,798,359, 3,956,615, 4,120,030, 4,168,396, 4,262,329, 4,306,289,
4,339,798, 4,375,579, 4,433,207, 4,434,464, 4,446,519, 4,471,163, 4,513,174

GROUP G

3,659,046, 3,731,197, 3,773,977, 3,824,467, 3,893,031, 3,911,216, 3,921,151,
3,970,790, 4,048,619, 4,058,830, 4,160,120, 4,171,513, 4,172,213, 4,196,310,
4,232,193, 4,283,602, 4,323,921, 4,337,483, 4,379,205, 4,434,323

GROUP H

3,668,307, 3,833,757, 3,894,176, 3,934,079, 3,997,718, 4,245,245, 4,339,798,
4,475,123, 4,528,589, 4,536,791

GROUP I

3,668,307, 3,845,391, 3,975,583, 4,247,106, 4,312,016, 4,329,684, 4,331,973,
4,331,974, 4,332,980, 4,334,242, 4,354,201, 4,361,877, 4,375,651, 4,394,691,
4,404,589, 4,475,123, 4,528,588, 4,528,589, 4,536,791, "The wired household," IEEE
Spectrum, Oct. 1979

GROUP J

3,729,581, 4,031,548, 4,079,419, 4,081,753, 4,170,782, 4,186,413, 4,264,925,
4,288,809, 4,305,101, 4,329,684, 4,331,973, 4,331,974, 4,336,559, 4,375,651,
4,390,901, 4,394,691, 4,404,589, 4,598,288, All Foreign Patents, All Articles

GROUP K

3,733,430, 3,803,491, 3,833,757, 3,845,391, 4,025,851, 4,081,753, 4,104,486,
4,170,782, 4,230,990, 4,250,524, 4,338,628, 4,528,588, "The wired household," IEEE
Spectrum, Oct. 1979

GROUP L

3,749,845, 3,825,893, 4,048,619, 4,049,906, 4,058,830, 4,081,612, 4,247,106,
4,284,976, 4,287,592, 4,306,305, 4,307,446, 4,314,367, 4,319,079, 4,332,980,
4,347,498, 4,413,339, 4,536,791, 4,689,661, All Articles

GROUP M

3,749,845, 4,049,906, 4,081,612, 4,284,976, 4,307,446, 4,332,980, 4,347,498,
4,400,587

GROUP N

3,798,137, 3,893,031, 3,911,216, 3,921,151, 4,172,213, 4,168,396, 4,200,770,
4,215,366, 4,283,602, 4,304,990, 4,306,305, 4,316,055, 4,319,079, 4,365,110,
4,375,579, 4,389,671, 4,433,207, 4,471,164

GROUP O

3,833,757, 3,842,196, 3,891,792, 3,916,091, 3,975,583, 4,186,413, 4,247,106,
4,288,809, 4,310,854, 4,337,483, 4,339,798, 4,425,581, 4,536,791, All Articles

GROUP P

3,893,031, 4,305,131, 4,316,245, 4,395,757, 4,405,942, 4,424,532, 4,425,581,
4,434,323

GROUP Q

4,264,925, 4,305,131, 4,329,684, 4,339,798

GROUP R

4,302,771, 4,381,522

GROUP S

4,312,016, 4,332,980, 4,334,242, 4,337,480, 4,394,691, 4,488,179, 4,536,791

"The wired household," IEEE *Spectrum*, Oct. 1979

OTHER PATENTS UNCLASSIFIED BY GROUP

4,025,947, 4,138,726, 4,200,913, 4,236,217, 4,275,411, 4,290,141, 4,295,223,
4,316,245, 4,340,903, 4,395,757, 4,689,661



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5634/008

RECEIVED

SEP 11 1995
GROUP 2602

#11/Reg. for
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5/18/95

In re Application of
JOHN C. HARVEY
JAMES W. CUDDIHY

Group Art Unit: 2602

Serial No.: 08/113,329

Examiner: Harvey, D.

Filed: August 30, 1993

For: SIGNAL PROCESSING
APPARATUS AND METHODS

File No.: 5634/008

**REQUEST FOR RECONSIDERATION OF
DOUBLE-PATENTING REJECTION AND
REQUEST FOR CONSIDERATION OF PREVIOUSLY
SUBMITTED INFORMATION DISCLOSURE STATEMENTS**

Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Sir:

REQUEST FOR RECONSIDERATION OF DOUBLE PATENTING REJECTION

The Office Action mailed April 20, 1995 (paper #10) has been carefully reviewed and the following remarks respectfully submitted in response thereto. All pending claims (nos. 1-3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44 and 49-84) stand rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1-13 of U.S. Patent No. 4,694,490 ("the '490 patent"). For the following reasons, it is respectfully submitted that the Office Action has misapplied the doctrine of obviousness-type double patenting to Applicants' claims.

Reconsideration is respectfully requested.

1. The Law of Double Patenting

Under the law of double patenting, there are two relevant questions. The first question in the analysis is: Is the same invention is being claimed twice? General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1278, 23 U.S.P.Q.2d 1839, 1843 (Fed. Cir. 1992); In re Vogel, 422 F.2d 438, 441, 164 U.S.P.Q. 619, 621 (C.C.P.A. 1970). 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Invention" here means what is defined by the claims. Vogel, 422 F.2d at 441, 164 U.S.P.Q. at 621. If the claims define identically the same invention, 35 U.S.C. 101 forbids the grant of the second patent, regardless whether a terminal disclaimer is filed. Vogel, 422 F.2d at 441, 164 U.S.P.Q. at 622.

If the answer to this first question is no, then a second question must be asked. Vogel, 422 F.2d at 441, 164 U.S.P.Q. at 622; General Foods, 972 F.2d at 1278, 23 U.S.P.Q.2d at 1843. The second question in the analysis is: Does any claim in the application define an obvious variation of an invention claimed in the patent? Id. If any claim in the application is obvious in view of any claim in a patent cited in support of a double patenting rejection, an obviousness-type double patenting rejection may be overcome by filing a terminal disclaimer as provided under 35 U.S.C. 253. General Foods, 972 F.2d at 1280, 23 U.S.P.Q.2d at 1845. However, where the two claimed inventions are patentably distinct, no disclaimer is required. Id.

In considering these questions, the well established law as set forth by the United States Court of Appeals for the Federal Circuit and its predecessor courts makes clear that the patent disclosure of a patent cited in support of a double patenting rejection may not be used as prior art. General Foods, 972 F.2d at 1281, 23 U.S.P.Q.2d at 1846; ("...[I]t is important to bear in mind that comparison can be made only with what invention is claimed in the earlier patent..."); General Foods, 972 F.2d at 1280, 23 U.S.P.Q.2d at 1845 (emphasis original); Vogel, 422 F.2d at 441, 164 U.S.P.Q. at 621; In re Plank, 399 F.2d 241, 242, 158 U.S.P.Q. 328, 329 (C.C.P.A. 1968); In re Boylan, 392 F.2d 1017, 1018 n.1, 157 U.S.P.Q. 370, 371 n.1 (C.C.P.A. 1968).

2. Applicants' Claims Are Patentably Distinct From Claims 1-13 of U.S. Patent No. 4,694,490

Applying the double patenting test set forth above, none of Applicants' claims are obvious in view of the invention(s) claimed in the '490 patent.

Claims 1-13 of the '490 patent relate to a method/apparatus for communicating programming to a plurality of receiver stations, and generating and displaying a user specific overlay that is related to the received programming. The user specific overlay is generated and displayed in response to the receipt of an instruct-to-overlay signal. In this manner, a display is presented that includes the television programming and the user specific computer generated overlay.

In contrast, all of Applicants' pending claims are directed to apparatus or methods for controlling at an intermediate transmission station the communication of television programming to a subscriber and include a number of claimed features that are different from those claimed in the '490 patent. For example, all of Applicants' claims (except claims 10, 13, 16, 18 and 19) include the communication of a unit of television programming according to a programming schedule. The programming schedule may designate, for example, a time or channel for communicating the unit of programming. Also, Applicants' pending claims 10, 13, 16, 18 and 19 are directed to a method of controlling the communication of television programming from a television programming source to a subscriber, and include the steps of receiving programming units from a remote source, loading a plurality of prerecorded units of programming onto a local programming source, receiving a plurality of signals from a remote source, each signal designating one unit of said loaded units or said received units, identifying the unit designated by each control signal, and communicating the identified unit. Moreover, none of Applicants' pending claims are directed to the generation or display of a user specific overlay in response to an instruct-to-generate signal, as claimed in the '490 patent.

Accordingly, it is respectfully submitted that none of Applicants' claims are obvious in view of claims 1-13 of the '490 patent. General Foods, 972 F.2d at 1278, 23 U.S.P.Q.2d at 1843; Vogel, 422 F.2d at 441, 164 U.S.P.Q. at 621. Applicants, therefore,

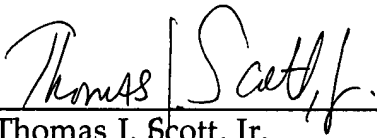
respectfully request that the obviousness type double patenting rejection be withdrawn.

**REQUEST FOR CONSIDERATION OF
PREVIOUSLY SUBMITTED INFORMATION DISCLOSURE STATEMENTS**

Information Disclosure Statements were filed in this application on November 29, 1993 and on February 1, 1994. However, no initialed copy of either Form PTO-1449 submitted with those IDS's has been received by Applicants. Attached to this Amendment are copies of those Information Disclosure Statements. Also attached are a copies of the postcards in Applicants' file bearing a PTO mailroom stamp, as evidence of the filing of the IDS's. Consideration of these two IDS's is respectfully requested. The Examiner is also requested to return initialed copies of the Form PTO-1449 for both IDS's attached hereto.

Respectfully submitted,

Date: May 11, 1995



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